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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/802,883	03/12/2001	Leo I. Rainer	00-240	5679
7590 07/02/2004				
William S. Bernheim 255 N. Lincoln St. Dixon, CA 95620			EXAMINER CIRIC, LJILJANA V	
			ART UNIT 3753	PAPER NUMBER

DATE MAILED: 07/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/802,883

Applicant(s)

Examiner

Ljiljana (Lil) V. Ciric

Art Unit

3753

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 March 2004, 24 December 2003, et al.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) 2-6, 8-11, 13, 15 and 17-31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 7, 12, 14 and 16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 December 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Response to Amendment*

1. This Office action is in response to the replies filed on March 25, 2004, on December 24, 2003, on November 10, 2003, on July 29, 2003, and on June 25, 2003.
2. Claims 1 through 31 remain in the application, of which claims 1 through 24 are amended, either directly or indirectly, and of which claims 25 through 31 are new.
3. The amendment filed on March 25, 2004, on December 24, 2004, on November 10, 2003, on July 29, 2003, and on June 25, 2003 are objected to under 35 U.S.C. 132 because they introduce new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows, for example: the functions and labeling of buttons 26, 27, 29, 30, and 37 changing when different screens are selected as added to the paragraph at page 9, lines 16 through 22 of the specification; the program code that controls ALL functions being contained in a microprocessor chip in control module 3 as added to the paragraph at page 9, lines 16 through 22 of the specification; the blower unit 15 being PREFERABLY powered by a (second?) variable motor 33 as added to the paragraph at page 9, line 23 to page 10, line 3 of the specification—note that the originally filed specification discloses a blower motor 15 which is *necessarily* a variable speed motor; the refrigerant passages of heat exchange coil forming upstream rows 10b in one embodiment with downstream rows 10a being used for space heating and “using a hot water loop [sic]” as added to the paragraph at page 9, line 23 to page 10, line 3 of the specification; that separate coils for heating and air conditioning may also be used as added to the paragraph at page 9, line 23 to page 10, line 3 of the specification; that outdoor air stream 34 may pass through optional one- or two-stage evaporative cooler 35 before entering damper 12 through duct 36 at entry 12 as added to the paragraph at page 9, line 23 to page 10, line 3 of the specification; and,

Art Unit: 3753

most of the material added via the THREE (3) NEW paragraphs added at page 124 [sic]—(at page 12?), line 1 of the specification.

Applicant is required to cancel the new matter in the reply to this Office Action.

***Response to Arguments***

4. Applicant's arguments filed on December 24, 2003, on November 10, 2003, and on June 25, 2003 have been fully considered but they are not persuasive with regard to the prior art rejections as cited in the previous Office action.

As a preface to the following traversal of applicant's arguments relating to the applicability of the prior art rejections of the claims as recited in the previous Office action, the examiner hereby notes that the claims in a pending application should be given their *broadest* reasonable interpretation. See *In re Pearson*, 181 USPQ 641 (CCPA 1974). Also refer to the rejection of the examined claims under 35 U.S.C. 112, second paragraph, and under 35 U.S.C. 102(b) as detailed in the body of this Office action.

In response to applicant's argument that the Han ('125) reference fails to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a variable speed fan being used to economize energy consumption or to reduce noise; the use of historical data in suggesting operating parameters; provisions for replacing stale air) are not per se recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Also in response to applicant's argument that the Han reference does not teach the use of historical data in suggesting operating parameters or make provisions for replacing stale air, applicant is respectfully reminded that claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). Also, "[A]pparatus claims cover what a device *is*, not what a device *does*. (Emphasis in original). *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469 15 USPQ2d 1525, 1528 (Fed. Cir.

Art Unit: 3753

1990).

Applicant's arguments thus fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

Applicant's arguments thus do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections.

#### *Election/Restrictions*

5. Newly submitted claims 25 through 31 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Newly submitted claims 25 through 31 are drawn to a process, whereas originally presented claims 1 through 24 are drawn to an apparatus. An apparatus and a process are distinct by definition if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case, the apparatus as claimed can be practiced using a process, which unlike the newly claimed process as claimed, specifically requires the steps of calculates a ventilation limit temperature that is greater than or equal to the minimum temperature setting and that increases with decreasing building cooling requirements to prevent over-cooling using an algorithm, of calculating the preferred speed for the air mover, for example. Alternately, the newly claimed process, unlike the apparatus as claimed, can be practiced using an apparatus which necessarily includes a filter to filter the indoor air. Because these inventions are distinct for the reasons given above and the search required for the process claims as newly presented is not required for the apparatus claims, and since applicant has received an action on the merits for the originally presented invention (i.e., the apparatus), this invention has been constructively

Art Unit: 3753

elected by original presentation for prosecution on the merits. Accordingly, claims 25 through 31 are hereby withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

6. Claims 2 through 6, 8 through 11, 13 through 15, and 17 through 31 also remain withdrawn from consideration as being drawn to inventions previously non-elected without traverse.

### *Drawings*

7. The replacement drawings for Figures 1 and 2 were received on December 29, 2003. These drawings are disapproved because they contain new matter while at the same time failing to fully obviate the objections to the drawings under 37 CFR 1.83(a) as cited in the previous Office action.

8. The proposed drawing correction and/or the proposed replacement sheets of drawings, filed on December 24, 2003 and received on December 29, 2003, have been disapproved because they introduce new matter into the drawings. 37 CFR 1.121(f) states that no amendment may introduce new matter into the disclosure of an application. The original disclosure does not support showing, for example, the refrigerant passages of heat exchange coil 10 forming upstream rows 10b with downstream rows 10a being used for space heating nor that outdoor air stream 34 may pass through an optional one- or two-stage evaporative cooler 35 before entering damper 12 through duct 36 at entry nor the duct system configuration as shown in replacement Figure 1 nor indoor temperature sensor 28 as being disposed on user interface 1 as shown in replacement Figure 2.

9. The drawings filed on March 12, 2001 are still objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the following features must be shown or the feature(s) canceled from the claim(s): the damper having first and second positions as recited in claim 1; an indoor temperature sensor as recited in claim 1; a microprocessor which is included by the controller as recited in claim 1; and, a compressor-based air conditioner condensing unit and evaporator coil as recited in claim 16. **No new matter should be entered.**

Art Unit: 3753

Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### *Specification*

10. Receipt and entry of the amended abstract is hereby acknowledged.
11. The amendment filed on March 25, 2004, on December 24, 2004, on November 10, 2003, on July 29, 2003, and on June 25, 2003 are objected to under 35 U.S.C. 132 because they introduce new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows, for example: the functions and labeling of buttons 26, 27, 29, 30, and 37 changing when different screens are selected as added to the paragraph at page 9, lines 16 through 22 of the specification; the program code that controls ALL functions being contained in a microprocessor chip in control module 3 as added to the paragraph at page 9, lines 16 through 22 of the specification; the blower unit 15 being PREFERABLY powered by a (second?) variable motor 33 as added to the paragraph at page 9, line 23 to page 10, line 3 of the specification—note that the originally filed specification discloses a blower motor

Art Unit: 3753

15 which is necessarily a variable speed motor; the refrigerant passages of heat exchange coil forming upstream rows 10b in one embodiment with downstream rows 10 being used for space heating and “using a hot water lop [sic]” as added to the paragraph at page 9, line 23 to page 10, line 3 of the specification; that separate coils for heating and air conditioning may also be used as added to the paragraph at page 9, line 23 to page 10, line 3 of the specification; that outdoor air stream 34 may pass through optional one- or two-stage evaporative cooler 35 before entering damper 12 through duct 36 at entry 12 as added to added to the paragraph at page 9, line 23 to page 10, line 3 of the specification; and, new disclosure added via the THREE (3) NEW paragraphs added at page 124 [sic]—(at page 12?), line 1 of the specification.

Applicant is required to cancel the new matter in the reply to this Office Action.

12. The disclosure is objected to because of the following informalities: the specification as amended refers to the same element both as a blower motor 15 [page 10, line 26, and other occurrences] and as a variable speed motor 33 [replacement paragraph beginning at page 9, line 23; and other occurrences].

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

13. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

14. Claims 1, 7, 12, 14, and 16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. For example, there appears to be no support in the disclosure as originally filed for claiming that the algorithms *calculate a preferred speed for the air mover* per se as now recited in independent apparatus claim 1, for



Art Unit: 3753

example. The associated added limitations to claim 1 and all claims depending therefrom thus represent new matter.

15. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

16. Claims 1, 7, 12, 14, and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 1, for example, recites the broad recitation "a means for air delivery" in lines 2-3, and the claim also recites the air delivery means as comprising "an air mover capable of variable speeds" which is the narrower statement of the range/limitation.

Applicant is reminded that a claim limitation is to be interpreted invoking 35 USC 112, sixth paragraph only if the claim limitation uses the phrase "means for" or "step for" *modified with functional language only*, and not by structure, material or acts for achieving the specified function. In claim 1, for example, applicant appears to attempt to invoke interpretation according to 35 USC 112, sixth paragraph by citing "a means for air deliver", "a means for dampering between indoor and outdoor air sources", and

Art Unit: 3753

“means for sensing temperature” in lines 2-5 of the claim, then later on recites the corresponding structures for achieving the specified function. These limitations are thus interpreted broadly and not as invoking 35 U.S.C. 112, sixth paragraph. *Cf. Seal-Flex, Inc. v. Athletic Track and Court Construction*, 172 F.3d 836, 849-50, 50 USPQ2d 1225, 1233-34 (Fed. Cir. 1999). Also *Cf. Morris*, 127 F.3d at 1055, 44 USPQ2d at 1028. Also *Cf. Rodime PLC v. Seagate Technology, Inc.*, 174 F.3d at 524, 531, 41 USPQ2d 1429, 1435-36 (Fed. Cir. 1999).

The limitation “said control means” [claim 1, line 20] lacks proper antecedent basis in the claim, thus rendering indefinite the claim and all claims depending therefrom. It is not clear, for example, whether this limitation refers to the “means for interpreting sensed temperature to provide a suggestion of how to control said system” or to the “means for accepting control parameters and using said parameters to control said system” as cited earlier in the claim.

The above is an indicative, but not necessarily an exhaustive, list of 35 U.S.C. 112, second paragraph, problems. Applicant is therefore advised to carefully review all of the claims for additional problems. Correction is required of all of the 35 U.S.C. 112, second paragraph problems, whether or not these were particularly pointed out above.

#### *Claim Rejections - 35 USC § 102*

17. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

18. As best can be understood in view of the indefiniteness of the claims, claims 1, 7, 12, 14, and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Han (‘125, of record).

Han (‘125) discloses a ventilation system essentially as claimed, including, for example: a temperature conditioning system 10 which reads on the air delivery means as recited in the claims of the

Art Unit: 3753

instant application; damper means or economizer damper 27 having first and second positions corresponding to providing air from an indoor source via supply air plenum 30 or an outdoor air source via the openable and closeable damper or economizer 27; an indoor sensor 28 which reads on the temperature sensing means as recited in the claims of the instant application; a control means including a digital keypad display 34 including buttons and keys and readable on the user interface; a programmed controller as depicted schematically in Figure 2 including a microprocessor or I/O processor 42; a heating element 14 which reads broadly on the heating coil as recited in claim 12 of the instant application; a condensing unit or condenser 18; and, an evaporator 20. Every fan or air is capable of at least slightly variable speeds.

The reference thus reads on the claims.

### *Conclusion*

19. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ljiljana (Lil) V. Ciric, whose telephone number is (703) 308-3925.

While she works a flexible schedule that varies from day to day and from week to week,

Art Unit: 3753

Examiner Ciric may generally be reached at the Office during the work week between the hours of 10 a.m. and 6 p.m. ET.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dave Scherbel, can be reached on (703) 308-1272.

The NEW central official fax phone number is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0861.

lvc

June 28, 2004



LJILJANA V. CIRIC  
PRIMARY EXAMINER  
ART UNIT 3753